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EXAMINER

CHOI, PETER Y

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/617,977	Applicant(s) ESPE, ROLF	
	Examiner PETER Y. CHOI	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,7,8 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7,8 and 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 4, 7, 8, and 11-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1, 2, 4, 7, 8, and 11-24, claim 1 recites that the fabric includes a warp and a weft that is each formed of a number of threads that are each oriented along an axis that extends across a plane of the fabric and wherein the axis of the warp threads are parallel to one another and generally transverse to the axis of the weft threads, the warp and weft threads woven together so that the axis are oriented in crossing directions generally throughout the fabric. Additionally, claim 11 recites that the weft is interwoven with the warp such that the threads of the warp extend in a generally linear woven direction and are substantially perpendicular to threads of the weft throughout the fabric. Additionally, claim 18 recites that the press pad has a warp and a weft such that threads of the weft are substantially aligned along a first axis within a plane of the press pad and threads of the warp are substantially aligned along a second axis that is nearly transverse to the first axis within the plane of the press pad. Applicant's specification as originally filed does not provide support for this exact structure.

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It should be noted that although Applicant recites that the claimed structure further clarifies a woven fabric (*see* Applicant's remarks of October 24, 2008, page 7 of 10), a woven fabric is not specifically set forth in Applicant's specification as originally filed. Additionally, even if Applicant appears to be describing a woven fabric, as inherently associated with usage of the terms "warp" and "weft" as set forth in Applicant's remarks of October 24, 2008, Applicant's specification does not teach the specific structure claimed as all woven fabric are not necessarily, for example, formed with the specific structure comprises a number of threads that are oriented in respective planes that are generally perpendicular to a plane of the fabric and that are parallel to one another and wherein the planes associated with the warp threads are generally transverse to the planes associated with the weft threads generally throughout the fabric.

Therefore, the limitations of claims 1, 11 and 18 appear to comprise new matter for the reasons set forth above.

Response to Arguments

3. Applicant's arguments filed May 18, 2009, have been fully considered but they are not persuasive. Applicant argues that the specification includes more disclosure than is necessary to support the claimed orientation of the warp and weft threads with respect to one another and with respect to the press pad. Examiner respectfully disagrees. The structure claimed does not have specific support in Applicant's specification as originally filed. For example, Applicant's specification does not teach that a number of threads are each oriented along an axis that extends across a plane of the fabric. Additionally, Applicant's specification does not teach that the weft is interwoven with the warp such that the threads of the warp extend in a generally linear woven

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direction and are substantially perpendicular to threads of the weft throughout the fabric.

Additionally, Applicant's specification does not teach that the press pad has a warp and a weft such that threads of the weft are substantially aligned along a first axis within a plane of the press pad and threads of the warp are substantially aligned along a second axis that is nearly transverse to the first axis within the plane of the press pad.

Additionally, although Applicant argues that the disclosure of the application supports a greater breadth than is currently defined by the present claims, the narrower structure claimed is not supported by Applicant's specification. Additionally, although Applicant argues that one skilled in the art would appreciate that a woven fabric, such as a linen or twill weave, includes a number of threads oriented in crossing directions, Applicant's specification does not disclose that the woven fabric is a linen or twill weave, or that such weaves are suitable for the claimed invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4, 7, 8, and 11-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2001/0029139 to Espe in view of EP 1040910 to Best (with USPN 6,342,457 cited as the translation of EP 1040910).

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Regarding claims 1, 2, 4, 7, 8, 21, and 22, Espe appears to teach a press pad comprising a fabric that includes a warp and a weft that is each formed of a number of threads that are each oriented along an axis that extends across a plane of the fabric and wherein the axis of the warp threads are parallel to one another and generally transverse to the axis of the weft threads, the warp and weft threads woven together so that the axis are oriented in crossing directions generally throughout the fabric, and wherein one of the warp or weft includes a pattern of thread, the pattern repeating itself in the fabric, wherein the thread comprises a sheath made of an elastomeric material and a core with a higher tensile strength than the sheath, wherein the core of one of the types of thread is metal based (see entire document including paragraphs 0002-0026, 0028, 0034-0039, 0041, 0042). It should be noted that the structure of the fabric claimed appears to be inherent to the woven fabric of Espe, absent evidence to the contrary. Additionally, it would have been obvious to one of ordinary skill in the press pad art at the time the invention was made to form the press pad of the prior art, wherein the warp threads are generally parallel to one another and the weft threads are generally parallel to one another and wherein the warp and weft threads are interwoven in crossing directions generally throughout the fabric, motivated by the desire of forming a conventional press pad comprising a generally uniform woven fabric such that the pressing forces are uniformly transmitted over the entire surface of the work to be pressed.

Regarding claims 1, 2, 4, 7, 8, 21, and 22, Espe does not appear to teach that the pattern is a pattern of alternating types of thread, wherein the pattern of alternating types of threads includes at least two types of thread of different elasticities transverse to the thread axis, wherein each type of thread comprises a sheath made of an elastomeric material and a core with a higher

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tensile strength than the sheath, wherein the core of the other type of thread is polymer-based, and wherein a diameter of the first type of thread is generally equal to a diameter of the second type of thread such that the diameters of the two types of thread are generally equal. However, Espe teaches that the invention of Espe may comprise other yarns or other threads to achieve or adjust the resulting characteristics of the required pad (Id., paragraph 0042) and that it was known in the press pad art to combine metal yarn and aromatic polyamide in press pads (Id., paragraphs 0006-0016). Based on the teachings of Espe, one of ordinary skill in the art would recognize that advantageous characteristics of press pads include excellent thermal resistance and durability, chemical resistance against essentially all of the chemical compounds that typically arise in the use of press pads in pressing equipment, and very good padding and elasticity characteristics (Id., paragraph 0042).

Best is classified in the same field in the art as Espe, and teaches a substantially similar press pad for use in laminating presses, wherein the press pad is formed in a variety of basic weaves, wherein the press pad comprises thermally conductive metal threads and cushion threads, wherein the thermally conductive threads and cushion threads alternate in the fabric, the cushion threads comprising core plastic threads such as aramid threads, and an elastomeric thread sheath made of silicone elastomer or fluorosilicone elastomer or other rubber materials. (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2). Best teaches that the thickness of the cushion should be selected so that at the pressures usual in laminating presses, the cushion thread assumes the same thickness as the thermally conductive threads to ensure that the thread surfaces all lie in one plane during the pressing operation, thus yielding a maximum pressing area and uniform contact pressure, as well as optimized thermal

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conduction. Best teaches that the cushion threads impart compressive elasticity to the press pad, and guarantee the elasticity in thickness necessary for conformity with the pressed material.

When a work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another. If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill.

One of ordinary skill in the press pad art at the time the invention was made, when viewing the state of the press pad art and the predictable improvements in structures known in the art, would be motivated to improve the press pad of the prior art, with the cushion threads and structure taught by Best, since the improvements of Best were known to one of ordinary skill in the press pad art and it would have predictably improved similar articles in the same way. In the present case, it would have been obvious to one of ordinary skill in the press pad or cushion art at the time the invention was made to form the press pad of Espe, including the cushion threads and the structure of alternating generally equal diameter thermally conductive and cushion threads of Best, as Espe and Best are classified in the same field in the art, and motivated by the desire of forming a conventional press pad including cushion threads known in the art to predictably improve press pads by imparting compressive elasticity to the press pad and guaranteeing the elasticity in thickness necessary for conformity with the pressed material, and motivated by the desire of forming a conventional press pad with a structure known in the art to

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ensure that the thread surfaces all lie in one plane during the pressing operation, thus yielding a maximum pressing area and uniform contact pressure, as well as optimized thermal conduction.

Regarding claims 1, 2, 4, 7, 8, 21, and 22, the prior art does not appear to specifically teach that the cores of the two types of thread have a higher tensile strength than the sheath. However, the limitation requiring that the cores of the two types of thread having a higher tensile strength than the sheath appear to be inherent characteristics of the threads of the prior art since the prior art teaches substantially similar structures and compositions of the sheaths and cores as the claimed threads, as evidenced by Applicant's specification at pages 4 and 5. Products of identical structure and composition cannot have mutually exclusive properties. The burden is on the Applicant to prove otherwise.

Regarding claim 2, the prior art teaches that the at least two types of thread have polymer material at least on their lateral surfaces (Best, column 2 lines 8-55; Espe, paragraphs 0020-0026, 0028, 0034-0039, 0041, 0042, Figure).

Regarding claim 4, the prior art teaches that the at least two types of thread each are bunched or stranded from fibers (Best, column 2 lines 8-55; Espe, paragraphs 0020-0026, 0028, 0034-0039, 0041, 0042, Figure).

Regarding claim 7, the prior art teaches that the polymer based core is essentially made of polyamide (Best, column 2 lines 8-55).

Regarding claim 8, the prior art teaches that at least one of the cores is essentially bunched or stranded from fibers (Best, column 2 lines 8-55; Espe, paragraphs 0020-0026, 0028, 0034-0039, 0041, 0042, Figure).

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Regarding claims 11-17 and 23, Espe appears to teach a press pad comprising a warp and a weft, one type of thread including a core and a polymer material at least on its lateral surface, and wherein the core of one of the types of thread is metallic, and the weft being interwoven with the warp such that the threads of the warp extend in a generally linear woven direction and are substantially perpendicular to threads of the weft throughout the fabric (see entire document including paragraphs 0002-0026, 0028, 0034-0039, 0041, 0042). It should be noted that the structure of the fabric claimed appears to be inherent to the woven fabric of Espe, absent evidence to the contrary. Additionally, it would have been obvious to one of ordinary skill in the press pad art at the time the invention was made to form the press pad of the prior art, wherein the warp threads and weft threads are interwoven and the warp threads are substantially perpendicular to the weft threads throughout the fabric, motivated by the desire of forming a conventional press pad comprising a generally uniform woven fabric such that the pressing forces are uniformly transmitted over the entire surface of the work to be pressed.

Regarding claims 11-17 and 23, Espe does not appear to teach that at least one of the warp and weft includes a pattern of alternating types of threads having different elasticities transverse to a thread axis, each type of thread including a core and a polymer material at least on its lateral surface, wherein the core of the other type of thread is polymer-based, wherein the pattern of alternating types of threads repeats itself in the at least one of the warp and the weft, and wherein a diameter of the first type of thread is generally equal to diameter of the second type of thread. However, Espe teaches that the invention of Espe may comprise other yarns or other threads to achieve or adjust the resulting characteristics of the required pad (Id., paragraph 0042) and that it was known in the press pad art to combine metal yarn and aromatic polyamide

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in press pads (Id., paragraphs 0006-0016). Based on the teachings of Espe, one of ordinary skill in the art would recognize that advantageous characteristics of press pads include excellent thermal resistance and durability, chemical resistance against essentially all of the chemical compounds that typically arise in the use of press pads in pressing equipment, and very good padding and elasticity characteristics (Id., paragraph 0042).

Best is classified in the same field in the art as Espe, and teaches a substantially similar press pad for use in laminating presses, wherein the press pad is formed in a variety of basic weaves, wherein the press pad comprises thermally conductive metal threads and cushion threads, wherein the thermally conductive threads and cushion threads alternate in the fabric, the cushion threads comprising core plastic threads such as aramid threads, and an elastomeric thread sheath made of silicone elastomer or fluorosilicone elastomer or other rubber materials. (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2). Best teaches that the thickness of the cushion should be selected so that at the pressures usual in laminating presses, the cushion thread assumes the same thickness as the thermally conductive threads to ensure that the thread surfaces all lie in one plane during the pressing operation, thus yielding a maximum pressing area and uniform contact pressure, as well as optimized thermal conduction. Best teaches that the cushion threads impart compressive elasticity to the press pad, and guarantee the elasticity in thickness necessary for conformity with the pressed material.

When a work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another. If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a

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person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill.

One of ordinary skill in the press pad art at the time the invention was made, when viewing the state of the press pad art and the predictable improvements in structures known in the art, would be motivated to improve the press pad of the prior art, with the cushion threads and structure taught by Best, since the improvements of Best were known to one of ordinary skill in the press pad art and it would have predictably improved similar articles in the same way. In the present case, it would have been obvious to one of ordinary skill in the press pad or cushion art at the time the invention was made to form the press pad of Espe, including the cushion threads and the structure of alternating generally equal diameter thermally conductive and cushion threads of Best, as Espe and Best are classified in the same field in the art, and motivated by the desire of forming a conventional press pad including cushion threads known in the art to predictably improve press pads by imparting compressive elasticity to the press pad and guaranteeing the elasticity in thickness necessary for conformity with the pressed material, and motivated by the desire of forming a conventional press pad with a structure known in the art to ensure that the thread surfaces all lie in one plane during the pressing operation, thus yielding a maximum pressing area and uniform contact pressure, as well as optimized thermal conduction.

Regarding claims 12-17, the prior art does not appear to specifically teach that at least one weft thread and at least one warp thread has a sheath made of a polymer material and a core having a higher tensile strength than this sheath. However, the limitation requiring that the cores of the two types of thread having a higher tensile strength than the sheath appear to be inherent

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characteristics of the threads of the prior art since the prior art teaches substantially similar structures and compositions of the sheaths and cores as the claimed threads, as evidenced by Applicant's specification at pages 4 and 5. Products of identical structure and composition cannot have mutually exclusive properties. The burden is on the Applicant to prove otherwise.

Regarding claim 13, the prior art teaches that the metallic core is essentially made of brass (Best, column 2 lines 8-55; Espe, paragraphs 0020-0026, 0028, 0034-0039, 0041, 0042, Figure).

Regarding claim 14, the prior art teaches that the polymer-based core is essentially made of polyamide (Best, column 2 lines 8-55; Espe, paragraphs 0020-0026, 0028, 0034-0039, 0041, 0042, Figure).

Regarding claim 15, the prior art teaches that the warp has a core that is essentially bunched or stranded from fibers (Best, column 2 lines 8-55; Espe, paragraphs 0020-0026, 0028, 0034-0039, 0041, 0042, Figure).

Regarding claim 16, the prior art teaches that the at least one type of thread is bunched or stranded from fibers (Best, column 2 lines 8-55; Espe, paragraphs 0020-0026, 0028, 0034-0039, 0041, 0042, Figure).

Regarding claims 18-20 and 24, Espe appears to teach a press pad with improved pressure compression having a warp and a weft such that threads of the weft are substantially aligned along a first axis within a plane of the press pad and threads of the warp are substantially aligned along a second axis that is nearly transverse to the first axis within the plane of the press pad, wherein one type of thread has 1) a sheath that is an elastomer and has a high temperature stability above 200 degrees Celsius, and 2) a core, wherein one of the types of thread has a core

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that is metal based (see entire document including paragraphs 0002-0026, 0028, 0033-0039, 0041, 0042). It should be noted that the structure of the fabric claimed appears to be inherent to the woven fabric of Espe, absent evidence to the contrary. Additionally, it would have been obvious to one of ordinary skill in the press pad art at the time the invention was made to form the press pad of the prior art, wherein the warp threads and weft threads are each substantially aligned along separate axes and wherein each axis is nearly transverse to the other axis, motivated by the desire of forming a conventional press pad comprising a generally uniform woven fabric such that the pressing forces are uniformly transmitted over the entire surface of the work to be pressed.

Regarding claims 18-20 and 24, Espe does not appear to teach that at least one of the warp and the weft includes an alternating pattern of at least two types of threads of differing elasticities in the transverse to the thread axis, that each type of thread has 1) a sheath that is an elastomer and has a high temperature stability above 200 degrees Celsius, and 2) a core, wherein the core of each of type of thread all has a higher tensile strength than the sheath, wherein the core of another type of thread has a core that is polymer-based and wherein the diameters of the all of the types of thread in the alternating pattern are generally equal. However, Espe teaches that the invention of Espe may comprise other yarns or other threads to achieve or adjust the resulting characteristics of the required pad (Id., paragraph 0042) and that it was known in the press pad art to combine metal yarn and aromatic polyamide in press pads (Id., paragraphs 0006-0016). Based on the teachings of Espe, one of ordinary skill in the art would recognize that advantageous characteristics of press pads include excellent thermal resistance and durability, chemical resistance against essentially all of the chemical compounds that typically arise in the

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use of press pads in pressing equipment, and very good padding and elasticity characteristics (Id., paragraph 0042).

Best is classified in the same field in the art as Espe, and teaches a substantially similar press pad for use in laminating presses, wherein the press pad is formed in a variety of basic weaves, wherein the press pad comprises thermally conductive metal threads and cushion threads, wherein the thermally conductive threads and cushion threads alternate in the fabric, the cushion threads comprising core plastic threads such as aramid threads, and an elastomeric thread sheath made of silicone elastomer or fluorosilicone elastomer or other rubber materials. (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2). Best teaches that the thickness of the cushion should be selected so that at the pressures usual in laminating presses, the cushion thread assumes the same thickness as the thermally conductive threads to ensure that the thread surfaces all lie in one plane during the pressing operation, thus yielding a maximum pressing area and uniform contact pressure, as well as optimized thermal conduction. Best teaches that the cushion threads impart compressive elasticity to the press pad, and guarantee the elasticity in thickness necessary for conformity with the pressed material.

When a work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another. If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, § 103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill.

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One of ordinary skill in the press pad art at the time the invention was made, when viewing the state of the press pad art and the predictable improvements in structures known in the art, would be motivated to improve the press pad of the prior art, with the cushion threads and structure taught by Best, since the improvements of Best were known to one of ordinary skill in the press pad art and it would have predictably improved similar articles in the same way. In the present case, it would have been obvious to one of ordinary skill in the press pad or cushion art at the time the invention was made to form the press pad of Espe, including the cushion threads and the structure of alternating generally equal diameter thermally conductive and cushion threads of Best, as Espe and Best are classified in the same field in the art, and motivated by the desire of forming a conventional press pad including cushion threads known in the art to predictably improve press pads by imparting compressive elasticity to the press pad and guaranteeing the elasticity in thickness necessary for conformity with the pressed material, and motivated by the desire of forming a conventional press pad with a structure known in the art to ensure that the thread surfaces all lie in one plane during the pressing operation, thus yielding a maximum pressing area and uniform contact pressure, as well as optimized thermal conduction.

Regarding claims 18-20 and 24, the prior art does not appear to specifically teach that the core of each type of thread all has a higher tensile strength than the sheath. However, the claimed properties appear to be inherent characteristics of the threads of the prior art since the prior art teaches substantially similar structures and compositions of the sheaths and cores as the claimed threads, as evidenced by Applicant's specification at pages 4 and 5. Products of identical structure and composition cannot have mutually exclusive properties. The burden is on the Applicant to prove otherwise.

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Regarding claim 19, the prior art teaches that the polymer based core is essentially made of polyamide (Best, column 2 lines 8-55).

Regarding claim 20, the prior art teaches that the prior art teaches that at least one core is essentially bunched or stranded from fibers (Best, column 2 lines 8-55; Espe, paragraphs 0020-0026, 0028, 0034-0039, 0041, 0042, Figure).

Regarding claims 21 and 22, the prior art teaches that the diameters of the two types of thread are generally equal for generating a padding effect and a generally homogenous pressure distribution over an area of the press pad (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2).

Regarding claim 22, the prior art teaches that the press pad is incorporated into a pressing machine (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2; Espe, paragraphs 0020-0026, 0028, 0034-0039, 0041, 0042, Figure).

Regarding claim 22, the prior art does not appear to specifically teach that the pressing machine is constructed to apply a coating of a wear resistant melamine resin overlay to a material, and wherein the press pad is constructed to prevent graying of the wear resistant resin. However, the prior art teaches that it is conventionally known to use press pads in various types of high pressure and low pressure presses, for example short cycle presses and multi-daylight or multi-layer presses for pressing and laminating melamine sheets or the like onto wood fiberboard or plywood or the like, or high pressure presses for manufacturing high pressure laminates, and various other types of presses for many different uses in many different fields (Espe, paragraph 0003). Additionally, the claimed limitations appear to be intended uses of the pressing machine. A recitation of the intended use of the claimed invention must result in a structural difference

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between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since Applicant has not claimed any structural or compositional characteristics of the claimed pressing machine, it is presumed that the pressing machine recited in the prior art (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2; Espe, paragraphs 0002-0026, 0028, 0034-0039, 0041, 0042) is capable of performing the recited intended uses, absent evidence to the contrary. It should be noted that Applicant's remarks of December 12, 2006, recite that the claim only further defines the operation and function of the threads.

Regarding claim 23, the prior art teaches that the diameters of the types of thread are generally equal for generally equalizing different pressures across an area of the material (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2).

Regarding claim 23, the prior art does not appear to specifically teach that the diameter specifications are for preventing graying of a wear resistant overlay applied to a material processed proximate the press pad. However, the claimed limitation appears to recite an intended characteristic of the claimed invention rather than a positively recited structure required by the claimed invention. In other words, Applicant is not claiming a wear resistant melamine resin and characteristics associated with the resin; Applicant is only claiming that *when* a wear resistant melamine resin overlay is applied to a material processed proximate the press pad, the diameters *will* be useful for preventing graying. Therefore, the claimed limitation requiring that the diameter specifications are for preventing graying of a wear resistant melamine resin overlay applied to a material processed proximate the press pad and uniformly distributing the

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homogenous pressure distribution across an area of the wear resistant melamine does not appear to structurally or compositionally distinguish the claimed invention from the invention of the prior art. Additionally, the prior art teaches that the press pad generates a padding effect and a generally homogenous pressure distribution over an area of the press pad to ensure uniform contact pressure over the entire surface (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2). Therefore, one of ordinary skill in the art would expect that the press pad of the prior art would behave substantially similarly and/or identically as the claimed invention since the prior art teaches a substantially similar structure and composition as the claimed invention. It should be noted that Applicant's remarks of December 12, 2006, recite that the claim only further defines the operation and function of the threads.

Regarding claim 24, the prior art teaches that the diameters of all of the types of thread are generally equal for generating a padding effect and a generally homogenous pressure distribution over an area of the press pad (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2).

Regarding claim 24, the prior art does not appear to specifically teach that the diameter specification is for preventing graying of a wear resistant melamine resin overlay applied to a material processed proximate the press pad and uniformly distributing the homogenous pressure distribution across an area of the wear resistant melamine. However, the claimed limitation appears to recite an intended characteristic of the claimed invention rather than a positively recited structure required by the claimed invention. In other words, Applicant is not claiming that a wear resistant melamine resin and characteristics associated with the resin; Applicant is only claiming that *when* a wear resistant melamine resin overlay is applied to a material

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processed proximate the press pad, the diameters *will* be useful for preventing graying and uniformly distributing the homogenous pressure distribution across an area of the wear resistant melamine. Therefore, the claimed limitation requiring that the diameter specification is for preventing graying of a wear resistant melamine resin overlay applied to a material processed proximate the press pad and uniformly distributing the homogenous pressure distribution across an area of the wear resistant melamine does not appear to structurally or compositionally distinguish the claimed invention from the invention of the prior art. Additionally, the prior art teaches that the press pad generates a padding effect and a generally homogenous pressure distribution over an area of the press pad to ensure uniform contact pressure over the entire surface (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2). Therefore, one of ordinary skill in the art would expect that the press pad of the prior art would behave substantially similarly and/or identically as the claimed invention since the prior art teaches a substantially similar structure and composition as the claimed invention. It should be noted that Applicant's remarks of December 12, 2006, recite that the claim only further defines the operation and function of the threads.

Response to Arguments

6. Applicant's arguments filed May 18, 2009, have been fully considered but they are not persuasive. Applicant argues that the claimed invention exhibits unexpected results of compensation properties, unexpected local and punctual difference compensation, and unexpected relaxation performance, as described in the Declaration of May 18, 2009. It should

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be noted that the Declarant in the Declaration is the sole inventor of the currently examined application.

Regarding Applicant's arguments, Examiner respectfully disagrees. It should be noted that Applicant does not claim compensation properties, local and punctual difference compensation, or relaxation performance. Therefore, since such properties are not required by the claims, such differences, if any, do not evidence necessary structural differences between the claimed invention and the invention of the prior art. Additionally, Applicant's Declaration only compares what Declarant would have expected in the *claimed invention* juxtaposed with what Declarant found in the *claimed invention*. However, Declarant does not compare the *claimed invention* with the invention of the *prior art*. Additionally, Declarant does not set forth in what manner the claimed pads were tested and/or if the pads of the prior art were tested and what properties were exhibited in the pads of the prior art. Additionally, Declarant does not set forth objective and/or quantitative characteristics associated with the properties described. Therefore, the Declaration is not persuasive.

Additionally, although Declarant recites that there is no disclosure or suggestion in the Espe reference to form a press pad having alternating threads of different elasticities and to form a press pad having different elasticities provided with threads having a common outer diameter, Espe is not solely relied on to teach the claimed limitation. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. As set forth above, Espe teaches that the invention of Espe may comprise other yarns or other threads to achieve or adjust the resulting characteristics of the required pad (Id., paragraph 0042) and that it was known in the press pad art to combine metal yarn and aromatic polyamide in

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press pads (Id., paragraphs 0006-0016). Based on the teachings of Espe, one of ordinary skill in the art would recognize that advantageous characteristics of press pads include excellent thermal resistance and durability, chemical resistance against essentially all of the chemical compounds that typically arise in the use of press pads in pressing equipment, and very good padding and elasticity characteristics (Id., paragraph 0042).

Best is classified in the same field in the art as Espe, and teaches a substantially similar press pad for use in laminating presses, wherein the press pad is formed in a variety of basic weaves, wherein the press pad comprises thermally conductive metal threads and cushion threads, wherein the thermally conductive threads and cushion threads alternate in the fabric, the cushion threads comprising core plastic threads such as aramid threads, and an elastomeric thread sheath made of silicone elastomer or fluorosilicone elastomer or other rubber materials. (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2). Best teaches that the thickness of the cushion should be selected so that at the pressures usual in laminating presses, the cushion thread assumes the same thickness as the thermally conductive threads to ensure that the thread surfaces all lie in one plane during the pressing operation, thus yielding a maximum pressing area and uniform contact pressure, as well as optimized thermal conduction. Best teaches that the cushion threads impart compressive elasticity to the press pad, and guarantee the elasticity in thickness necessary for conformity with the pressed material.

Therefore, it would have been obvious to one of ordinary skill in the press pad or cushion art at the time the invention was made to form the press pad of Espe, including the cushion threads and the structure of alternating generally equal diameter thermally conductive and cushion threads of Best, as Espe and Best are classified in the same field in the art, and motivated

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by the desire of forming a conventional press pad including cushion threads known in the art to predictably improve press pads by imparting compressive elasticity to the press pad and guaranteeing the elasticity in thickness necessary for conformity with the pressed material, and motivated by the desire of forming a conventional press pad with a structure known in the art to ensure that the thread surfaces all lie in one plane during the pressing operation, thus yielding a maximum pressing area and uniform contact pressure, as well as optimized thermal conduction.

Applicant argues that paragraph 12 of the Declaration evidences that the Best reference teaches away from providing a pad having a woven construction. Examiner respectfully disagrees. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Best is not relied on to teach the woven construction. Best is relied on to teach that it was known in the press pad art to form a press pad, wherein the press pad is formed in a variety of basic weaves, wherein the press pad comprises thermally conductive metal threads and cushion threads, wherein the thermally conductive threads and cushion threads alternate in the fabric, the cushion threads comprising core plastic threads such as aramid threads, and an elastomeric thread sheath made of silicone elastomer or fluorosilicone elastomer or other rubber materials. (Best, column 1 line 4 to column 2 line 63, column 3 lines 10-49, claims 1-20, Figure 2). Best teaches that the thickness of the cushion should be selected so that at the pressures usual in laminating presses, the cushion thread assumes the same thickness as the thermally conductive threads to ensure that the thread surfaces all lie in one plane during the pressing operation, thus yielding a maximum pressing area and uniform contact pressure, as well as optimized thermal conduction. Best teaches that the cushion threads impart compressive elasticity to the press pad, and guarantee the elasticity in thickness

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necessary for conformity with the pressed material. Additionally, Best does not teach that alternating threads of different elasticities can not be used in a woven fabric. Therefore, Best does not appear to teach away from a pad having a woven construction.

Additionally, although paragraph 13 of the Declaration sets forth differences between the claimed press pad and each of the references individually, the rejection is based on the prior art combination. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Therefore, the Declaration is not persuasive.

Conclusion

7. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER Y. CHOI whose telephone number is (571)272-6730.

The examiner can normally be reached on Monday - Friday, 08:00 - 15:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter Y Choi/
Examiner, Art Unit 1794

/Andrew T Piziali/
Primary Examiner, Art Unit 1794